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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/384,182

Applicant(s)

KAY ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 29-47 and 61-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 29-47 and 61-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on 23 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. The previous restriction is maintained.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP §608.01(o), and MPEP §2181. The Examiner notes that the claims are replete with the following errors. Correction of the following examples in addition to the other instances of “means for” is required:

- a. The “first means for storing” as recited in claim 72.
- b. The “second means for storing” as recited in claim 72.
- c. The “sixth means for storing” as recited in claim 73.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32, 63-65, 67, 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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a. Claim 32 is indefinite. It is the Examiner's position that because Applicants recite "only if," the phrase contains a optional clause. Applicants' argues however that "Claim 32 does not recite an optional limitation" Because of Applicants arguments, the scope of claim 32 is now indefinite. See the discussion below in the section titled "Response to Arguments."

b. Claim 67 is indefinite. In particular, it is unclear if the phrase "the first database stores video programming schedule information" in claim 67 is in addition to, or in replace of, the first database storing first product related data and second product related data" in claim 61. The Examiner notes that the transitional phrase in claim 67 recites "wherein" indicating that following limitations are in replacement of the earlier phrase as recited in claim 61. Such an interpretation would fail the Infringement Test as noted in MPEP §608.01(n) III. If Applicants intended the phrase to be *in addition to*, they would have recited "further comprising" or similar language as recited in *e.g.* claim 62. See *CAE Screenplates Inc. v. Heinrich Fielder GmbH & Co. KG*, 224 F.3d 1308, 1317, 55 USPQ2d 1804, 1810 (Fed. Cir. 2000) ("In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.").¹ Therefore, the use of "further comprising" in claim 62 indicates a different meaning is intended in claims where "further comprising" is not used.

¹ See also *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987) (noting that the meaning of claim terms must be defined in a manner that is consistent with its appearance in other claims in the same patent).

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c. Claim 63 is also indefinite for the same reasons noted above. In other words, are the limitations following “the one second server” in replace of, or in addition to, the limitations from defining the “second server” in claim 61. See *CAE Screenplates*.

d. In claim 72, it is unclear what is the corresponding structure in the “means for storing the first product” As a quid pro quo for the convenience of employing § 112, paragraph 6, Applicants have a clear duty to clearly link or associate structure to the claimed function. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360, 54 USPQ2d 1308, 1313 (Fed. Cir. 2000) citing *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 29-37, 41, 42, 44-46, 61, 62, 66, and 69-73, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by PowerTV Inc, White Paper titled

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‘Applications and Service Infrastructure’ (“PowerTV”) and Mimura et. al. (U.S. 6,557,031)(“Mimura”).² PowerTV discloses a system with the following:

a first plurality of servers (servers on the Internet which may include an internet service provider such as compuserve, AOL, earthlink, or mindspring) each configured to communicate with a first plurality of network devices (user’s set-top boxes, or devices within the user’s home computer) associated with a first network (the network being internal to the customer’s home, place of business, or hotel room such (e.g. LAN)), the first servers receive a first product related request from one of the first one of the first plurality of network devices; the first plurality of servers could be two of the millions of Internet servers on the Internet;

a second server having a first database storing first product related data (descriptions of products, to transmit the stored first product related data to the servers (either via email or the WWW in HTML);

a central server having a second database storing first and second product related data, the central server configured to: transmit first and second product related data, receive the first product related request, and store the received request in the second database;

the first and second product related data stored in the first database are the first and second product related data transmitted by the central server (i.e., the second server transmits the data from the central server, a common internet function); the first plurality of servers is

² Because of Applicants’ arguments regarding inherency, this rejection is formulated as a multiple reference §102 rejection as expressly authorized by MPEP §2131.01 III.

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configured to transmit applications (java executing on the set top boxes or the PowerTV Web Browsers, page 23) operable to receive the product related data (java or web browser data); wherein the first product related data is a request to purchase a product (e.g. purchase a sweater or information via compuserve); the first network is a video broadcast network (figure 2, page 18); the first product related data is different from the second product related data (inherent); the first product related data stored in the first and second databases correspond to a preference of a user associated with a network device (the server stores the user's information accessible with a password); the first product related request (e.g. a request for a particular broadcast video) is transmittable to one of the network devices only if the one network device is tuned to one of the multiple broadcast channels (the operator is allowed to choose the content of programming, page 3); the first product related data transmitted to the one network device is viewable in conjunction with video programming broadcast over one channel (broadcast and two way communications with, for example, on-demand video, page 12).

The Examiner notes that PowerTV does not directly show a easy to read diagram of the complete system. This however does not mean in any way that the system is not anticipated. Mimura is provided only to show an example of an easy to read diagram of the overall system.

7. The Examiner notes that "system" by which Applicants' claims are rejected is the local Power TV system *in combination* with the Internet.

8. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and

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accustom meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,³ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements.⁴ Third, after receiving express notice in the previous Office Action⁵ of the Examiner's position that lexicography is *not* invoked, Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography *is* invoked). Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have also declined the Examiner's express invitation⁶ to be their own lexicographer.⁷

³ See the Examiner's previous Office Action mailed May 5, 2003, Paper No. 26, Paragraph No. 11.

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ See again the Examiner's previous Office Action, Paper No. 26, Paragraph No. 11.

⁶ *Id.*

⁷ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner.

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Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner now relies heavily and extensively on this interpretation.⁹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed October 6, 2003).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification.”)(citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 29-37, 41, 42, 44-46, 61, 62, 66, and 69-73, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as obvious over PowerTV in view of Mimura.¹⁰ It is the Examiner principle position that the second plurality of first servers and a third server are inherently disclosed since the PowerTV network is connected to *the Internet* and Internet contains countless servers.

However, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV as taught by Mimura include the duplicate servers and networks. Such a modification would have merely expressly disclosed that which is inherent.

11. Additionally,, if the sever structure was not inherent, it too would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV and/or Mimura and include the claimed server structure. It is the Examiner's position that absent evidence of new or unexpected results, it is not inventive in terms of patentability to take one or

¹⁰ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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more servers ($S_1, S_2, S_3, \dots S_N$) which perform one or more tasks ($T_1, T_2, T_3, \dots T_N$) and add (or subtract) an additional number of servers (X) to perform all or part of the same tasks by allocating the tasks between the various servers (*i.e.* S_1 and S_{N+1} perform T_1 , S_2 and S_{N+2} perform T_2 , S_3 and S_{N+3} perform T_3 , ... S_N and S_{N+X} perform T_N). The prior art is replete with examples showing why such scaling (both increasing and decreasing) is desirable.¹¹

12. In other words, a modification increasing the number of servers (*e.g.* having two servers perform a task previously performed by one server) is analogous to making functions, structures, or actions separable. It is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as separable or releasable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable or releasable. See MPEP §2144.04 *V. C.* and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). As noted above, it is desirable to allocate the server tasks to various servers to help reduce bandwidth bottlenecks and to help increase the

¹¹ See *e.g.* Watson (U.S. 6,223,209 B1) disclosing distributed satellite world wide web servers containing identical information placed strategically throughout the Internet so as to be close to all potential clients to help reduce traffic bottlenecks; Midgely et. al. (U.S. 5,592,611 A) disclosing additional servers as a stand-in for a failed server so that client service requests are transparent to the user; Kriegsman (U.S. 6,370,590 B2) disclosing multiple servers as secondary web servers to optimize file transfers; Burns et. al. (U.S. 6,298,373 B1) disclosing cache servers which download content during off-peak hours to reduce traffic bottlenecks; Stiles (U.S. 6,219,692 B1) which discloses sending essentially identical tasks to multiple servers with differing processing loads to find the most preferred server provider; Zdepski et. al. (U.S. 5,825,884) disclosing an transactional server for TV networks; *How Networks Work*, Chapter 17 describing how sever based structures benefit from economies of scale in addition to offering security, excellent data management, fast response, and room for expansion; and *How the Internet Works*, Chapter 44 implementing a server based architecture in Internet e-commerce.

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benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion.

13. Likewise, a modification reducing the number of servers (*e.g.* from two servers to one server) is analogous to making functions, structures, or actions integral. It is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as being integral, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element integral. See MPEP §2144.04 *V. B.* citing *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). In this case, it is desirable to consolidate server tasks and reduce the number of servers in order to reduce operating and capital costs (*e.g.* electricity and server hardware respectively). For example, such a reduction took place in the late 1900's when the businesses consolidated large mainframe servers into a reduced number of IBM or Macintosh based servers.

14. After review of the intrinsic evidence, the Examiner finds that Applicants have not asserted any new or unexpected results of their server system. Absent such new or unexpected results, such modifications either increasing or decreasing the number of servers or even reassigning tasks to different server(s) would have helped maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.

15. Claims 38-40 and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over PowerTV/Mimura in view of Condon (U.S. 5,956,714). The PowerTV/Mimura combination

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discloses as discussed above and does not directly disclose using priority queues. Condon teaches using priority based queues in a plurality of servers to increase efficiency in a database.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV as taught by Condon to include the following high and low priority queues. Such a modification would have reduced the processing time for high priority queries in the database.

16. Claims 43, 67, 68, are rejected under 35 U.S.C. 103(a) as being unpatentable over the PowerTV/Mimura combination in further view of Knudson et. al. (U.S. 6,016,141) ("Knudson"). The PowerTV/Mimura combination discloses as discussed above and does not directly disclose transmitting video programming schedule data. Knudson teaches transmitting video programming schedule data

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV as taught by Knudson to include transmitting video programming schedule data and other. Such a modification would have reduced the processing time for high priority queries in the database.

Moreover, the missing elements in the PowerTV/Mimura combination are only found in the nonfunctional descriptive material and are not functionally involved in the claimed system

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of PowerTV/Mimura combination with any type of content. The descriptive material will not distinguish the claimed invention over the prior art

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in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). See also MPEP §2106 IV *B*.

Response to Arguments

17. Applicants' arguments filed September 23, 2003 (within Paper No. 27) have been fully considered but they are not persuasive.

18. Applicants' arguments with respect to the "architecture" have been considered but are moot in view of Applicants' amendments.

19. Applicants argue that "numerous limitations in the claims have been entirely ignored. Since there has been no claim-by-claim analysis (let alone an element-by-element analysis) present in the Office Action, it is not even clear if all the claims have been considered."¹²

First, the Examiner is unaware of any requirement where the Examiner is required to spell out each and every minute detail during an anticipation or obviousness rejection. Second, all claims have been considered (all elements have been considered as well). No limitations have been ignored.

20. Regarding Applicants' assertion of what is and what is not evidence, it is the Examiner's position that all documents of record are evidence for what they disclose.

21. On page 15 of Applicants' Remarks, Applicants argue:

¹² Applicant's Remarks, Paper No. 27, Page 14, last paragraph.

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Claim 32 does not recite an optional limitation but rather an express mandatory limitation that the first product related request is receivable from the one network device and the first product related data is transmittable to the one network device only if the one network device is tuned to one of the multiple broadcast channels.¹³

First, all limitations are express. (If Applicants are aware of any non-express or implicit limitations in the claims, they are requested to point these out in their next response.)

Second, as noted above, all limitations must be considered so they are in a sense, mandatory. Again, *all limitations are considered*. This however does not mean that all limitations are given patentable weight.¹⁴ Its evident that Applicants' arguments continue to confuse this important point. Because of Applicants' confusion, characterizing limitations as "an express mandatory limitation" adds no substance to the argument since all limitations are express and must be considered.

Even so, suppose the one network device is *not* tuned to one of the multiple broadcast channels, what then is the scope of this claim? Because Applicants expressly recite the term "if," the Examiner finds that claim 32 recites two optional phrases: first, if the one network device *is* tuned to one of the multiple broadcast channels; and second if the one network device is not tuned to one of the multiple broadcast channels. "When a claim covers several structures or

¹³ Applicant's Remarks, Paper No. 27, Page 15, 4th paragraph.

¹⁴ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.); *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

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compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (citations omitted). The Examiner elects the later for anticipation.

To be clear, the Examiner has not ignored, any limitations. If Applicants really desired to simply claim only an affirmative situation where the one network device is tuned to one of the multiple broadcast channels, Applicants could have simply stated: ‘the one network device is tuned to one of the multiple broadcast channels and the first product related request is receivable from the one network device and the first product related data is transmittable to the one network device.’ However, as of the date below, they have not stated this recitation in claim 32.

Applicants arguments seem to be based upon the Examiner’s example language (provided above) instead of the *actual claim language* which states “only if.” In other words, Applicants seem to ignore the ‘express mandatory limitation’ “only if.”

22. Applicants’ also argue “Accordingly, the Examiner’s assertions set forth in paragraphs 11-15 of the Office Action, to the extent addressed above, are traversed.”¹⁵ To the extent that Applicants arguments are set forth in their reply, they are acknowledged. However to the extent that Applicants’ arguments are *not* set forth in their reply, the Examiner continues to rely on those assertions including those stated in paragraphs 11-15 of Paper No. 26.

¹⁵ Applicant’s Remarks, Paper No. 27, Page 15, 5th paragraph.

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23. Applicants' arguments on pages 15 and 16 are acknowledged. Specifically, Applicants argue that "notwithstanding the significant effort which are now being undertaken to develop the logic for PC's to function in new and nonobvious ways, a computer capable of so functioning is never patentable. It is respectfully submitted that the Examiner's position flies in the face of number decisions of the Supreme Court and Federal Circuit."

To be clear, the Examiner maintains his position (and as noted by Applicants) that "a computer capable of so functioning is never patentable." Yes, the off-the-shelf "computer" is not patentable to the user.¹⁶ In other words, the ordinary computer coming off the assembly line at Gateway or Compaq or IBM is *the same computer* Applicants are now reciting in their claims. It is important to keep in mind that it is agreed that a computer capable of so functioning *is* patentable if novel and nonobvious or physical *structure* is recited by the inventors thereof (i.e. by the inventors at e.g. Gateway, Compaq or IBM) but this is not our case.

In other words, the inventors at e.g. Gateway, Compaq or IBM may have received a patent for their claimed machine. In doing so, their patent covers *all* uses of their claimed structure. See e.g. *Augustine Medical, Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 50 USPQ2d 1900, 1908 (Fed. Cir. 1999) (where product claims give patent protection covering "all uses" for the claimed product). In summary, "a computer capable of so functioning is never patentable"

¹⁶ The Examiner notes that the context of this discussion is in elected *product claims* and not processes. Clearly new and nonobvious processes are patentable but Applicants have elected the product in this application. See the Restriction in Paper No. 12 and confirmation of Applicants' election in Paper No. 14.

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because “the computer” *must* have already been invented by the inventor at Gateway, Compaq or IBM. The Examiner has again reviewed Applicants’s specification and can find no discussion or mention of Applicants inventing (structurally) a new computer.

24. Regarding Applicants arguments that their Representative’s computer is not “configure to perform” all the tasks in claim 42, the Examiner disagrees. It is extremely important to keep in mind that Applicants have *not* claimed that the various functions are actually performed—only that they are *capable of* being performed. Therefore, Applicants’ own PC (albeit with the proper software) is capable of performing the claimed functions. The Examiner admits that *if* Applicants actually claimed their computer performing the recited functions, the Representative’s computer would not meet those limitations.

25. Applicants also disagree with the Examiner’s example to an automobile chassis and state that is “incorrect.” The Examiner unaware of how examples can be “incorrect.” Analogies and examples may be imprecise or not on point, but how they are “incorrect” is unclear.

26. Applicants state that “The chassis is not configured to transport people until at least some additional elements, such as a seat, engine and wheels are added.” Applicants’ response is a great example illustrative of Applicants’ confusion.

First, chassis by definition do not have seats. Chassis do not have engines. And chassis do not have wheels. Vehicles have seats, an engine, and wheels. Applicants argument has in effect improperly changed “chassis” to “vehicle.” But the Examiner chose chassis for this exact point. There are *no changes* to the chassis and thus no motivation to combine. It is agreed that

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the chassis may be in need of being placed within a vehicle to ultimately perform the transporting, but the example language does not require this function. The key inquiry is to determine whether or not the claimed *item at issue* needs to be modified. Again, in the Examiner's example, the chassis needs no modification—none. Although it needs other structure *external to the chassis* (such as the seats, engine, and wheels) in order to perform the claimed function, the chassis *itself* requires *no* structural changes. The chassis is therefore “configured to transport people.”

27. Just as the chassis requires no structural changes, the prior art computer *itself* requires no structural changes to meet Applicants' claimed invention. Although it is agreed that additional structure *external to the computer* is required (such as a particular computer program) to ultimately perform the various functions, there are *no changes* to the computer itself because Applicants have *not actually claimed* performance of the recited functions. Prior to receiving *any* computer program, the computer itself is “configured to transmit,” “configured to store” and “configured to receive” the claimed information. Just as Applicants have improperly changed ‘chassis’ to ‘vehicle’ above, Applicants' arguments have improperly changed the claimed first, second, central, and other servers to servers that actually *perform* the recited functions. As Judge Clevenger has so eloquently summarized these types of arguments, “The invention disclosed in [Applicant's] written description may be outstanding in its field, but the name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

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Conclusion

28. Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

29. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

30. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or

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common sense to one of ordinary skill in this art. Each reference is cited in its entirety.

Moreover, because these three references are directed towards beginners (see e.g. “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03, the Examiner finds that these three references are primarily directed towards those of low skill in this art.

Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

31. Because this application is now final, Applicants are reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art).

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Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

32. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (*e.g.* PowerTV) and expressly noted its content, the other documents now of record were also considered and applied when making the Examiner's factual findings and conclusions of law. Moreover, because many of the canons of claim construction are generally viewed from a person of ordinary skill in the art,¹⁷ the other documents of record not specifically mentioned in the prior art rejections above were nevertheless used in the Examiner's deliberative process to access, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

33. It is the Examiner's factual determination that all limitations in the examined claims have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and

¹⁷ See *e.g.* *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

34. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (Paper No. 27 beginning on page 13) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied¹⁸, the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in their next properly filed response*. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have *any* questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are

¹⁸ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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unsuccessful, the examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

A handwritten signature in black ink, appearing to read "A. Fischer", followed by the date "10/6/03". The signature is written in a cursive, flowing style.

Andrew J. Fischer
Patent Examiner

AJF
October 6, 2003